IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Bednasz

Serial No.: **10/829,637**

Filed: **April 22, 2004**

For: **Hands-Free Reminder for a Wireless Communications Terminal**

Docket No: **2002-060**

PATENT PENDING

Examiner: Olivia M. Marsh

Group Art Unit: 2686

Confirmation No.:7060

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

☒ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

☐ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

July 5, 2006
Date

Kathleen Koppen

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants submit the following remarks in support of the Pre-Appeal Brief Request for Review attached herewith. Claims 1-13 and 15-42 are currently pending. The independent claims, claims 1, 16, and 30, are finally rejected under 35 U.S.C. §103(a) as being obvious over Willner (U.S. Pat. App. Pub. No. 2003/0032434) in view of Furuta (JP 2002-176678). However, the §103 rejection is based solely on impermissible hindsight reconstruction, and thus, fails as a matter of law.

Independent claims 1, 16, and 30 are directed to a wireless communications device, such as a mobile terminal, that automatically activates and deactivates a hands-free-only mode of the device based on a two-part decision. The first part of the decision is based on the proximity of the device to a known "hands-free zone" (i.e., a geographical area requiring the use of a hands-free device while driving a vehicle), and the second part is based on the velocity of the device while proximate the hands-free zone. Together, the two-part decision permits the

device to determine whether a user is driving through a hands-free zone in a vehicle (in which case the device would activate the hands-free mode), or walking down the street or sitting in a restaurant within the hands-free zone (in which case the device would deactivate the hands-free only mode).

Both Willner and Furuta disclose network controllers that place a wireless device in a hands-free mode. However, neither reference, alone or in combination, teaches or suggests a wireless communications device that activates/deactivates a hands-free only mode based on the claimed two-part decision. In Willner, the decision on whether the wireless device should or should not be in the hands-free mode is based solely on a geographical location of the wireless device. Willner, as the Examiner admits, never considers the velocity of the wireless device in deciding whether to place the wireless device in the hands-free mode. In Furuta, the decision on whether a mobile phone should or should not be in the hands-free mode is based solely on the velocity of a vehicle in which the device is traveling. Furuta does not consider the proximity of the mobile phone to a hands-free zone.

Yet, the Examiner asserts that one skilled in the art would be motivated to combine these references because doing so would "assist the mobile user in obeying laws forbidding the mobile terminal from operating while driving for safety purposes." *Final Office Action*, p. 6, ll. 4-16. This alleged motivation to combine is misleading for its generality. The question of safety is independent of whether one is or is not using a cell phone while driving a vehicle. Most drivers wish to be safe regardless of their location and regardless of what the laws associated with that location are. Safety has nothing to do with ensuring that motorists who may not live in a particular hands-free jurisdiction comply with unknown laws. Because compliance is specific to a jurisdiction (i.e., laws differ from place to place), Willner makes a decision on whether to enter a hands-free mode based solely on the geographical location of the device. Willner does not need or desire both the location and the velocity of the wireless device to make a decision.

Furuta may be concerned with user safety, but only in the sense that driving a vehicle while talking on a mobile phone is generally unsafe. Thus, the only information of any importance in Furuta is whether the mobile phone is or is not moving greater than a specified velocity.

It appears as though the Examiner has merely identified a combination of parts in a plurality of references. However, doing so is not enough to render the invention obvious. If it were, then many inventions could instantly be rendered obvious, effectively eviscerating 35 U.S.C. §103 as well as the most of the body of case law that interprets it.

> As this court has stated, 'virtually all [inventions] are combinations of old elements.' (citations omitted). Therefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability' (citations omitted).

In re Rouffet, 149 F3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998) (emphasis added).

In this case, the Examiner has cited two different references. Both relate to a hands-free mode in a wireless device; however, both accomplish their goals using different methods and for different reasons. According to Willner, any device within a predefined geographical area would operate in a hands-free mode regardless of whether the user was driving a car or sitting still within a restaurant. According to Furuta, a device would operate in the hands-free mode so long as it is moving in a vehicle regardless of whether the laws of the particular area through which the user is driving prohibited such behavior. The only document that considers both aspects in a decision to place a device in a hands-free mode is Applicant's claimed invention, which the Examiner has used as "a blueprint a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention." *Id.* The Federal Circuit has long held such rejections *legally improper.*

In sum, claims 1 and 30 explicitly require activating and deactivating a hands-free mode in a wireless device based on information indicative of both the location and the velocity of the mobile device. Claim 16 is directed to a communications system that includes a mobile terminal configured to operate in the hands-free mode based on both the location and the velocity of the mobile terminal. Therefore, for the reasons stated above, the cited references do not teach or suggest, alone or in combination, the claimed invention. Accordingly, Applicant respectfully requests that the Panel overturn the §103 rejections.

Respectfully submitted,

COATS & BENNETT, P.L.L.C.

Dated:July 5, 2006

Stephen A. Herrera
Registration No.: 47,642

P.O. Box 5
Raleigh, NC 27602
Telephone: (919) 854-1844
Facsimile: (919) 854-2084

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0661-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): **2002-060 / PU04 0044US1**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

Date: **July 5, 2006**

Signature: Kathleen Koppen

Typed or printed name: **KATHLEEN KOPPEN**

Application Number:	Filed:
10/829,637	**April 22, 2004**

First Named Inventor: **Bednasz**

Art Unit:	Examiner:
2686	**OLIVIA M. MARSH**

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record
Registration Number: 47,642

☐ attorney or agent acting under 37 CFR 1.34.
Registration Number if acting under 37 CFR 1.34_____

Signature

Stephen A. Herrera
Typed or Printed Name

(919) 854-1844
Telephone Number

July 5, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ form(s) is/are submitted.

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. [1] Applicant's unique citation designation number (optional). [2] Applicant is to place a check mark here if English language Translation is attached.This collection of information is required by 37 CFR 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.